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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/014,670

12/14/2001

Agathe Subtil

216907US0X

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10/03/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FORD, VANESSA L

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 10/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/014,670

Applicant(s)

SUBTIL ET AL.

Examiner

Vanessa L. Ford

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- | | |
|------------|--|
| Group I | Claims 1-6 and 15-18 are drawn to a <i>Chlamydia</i> polypeptide, immunogenic composition and vaccinating composition, classified in class 530, subclass 300. |
| Group II | Claims 7-10 are drawn to a method of identifying a secreted <i>Chlamydia</i> polypeptide, classified in class 435, subclass 7.1. |
| Group III | Claims 11-14 are drawn to a method of screening an active molecule inhibiting the secretion of a secreted <i>Chlamydia</i> polypeptide, classified in class 435, subclass 7.2. |
| Group IV | Claim 19 is drawn to a therapeutic composition comprising an active molecule, classified in class 424, subclass 190.1. |
| Group V | Claim 20 is drawn to an antibody, in class 424, subclass 130.1. |
| Group VI | Claims 21-22 are drawn to a method for diagnosing a <i>Chlamydia</i> infection, classified in class 435, subclass 7.36. |
| Group VII | Claims 23-28 are drawn a plasmid and host cell, classified in class-536, subclass 23.1. |
| Group VIII | Claim 29 is drawn to a method of preventing or treating a <i>Chlamydia</i> infection in a mammal, classified in class 424, subclass 263.1. |

2. Groups I, IV, V and VII are different products. The inventions are patentably distinct, each from the other, because they are different structurally and functionally.
3. Groups I and (II, III and VI) are unrelated as product and method of using. The product of Group I is not required for the method of Groups (II, III and VI).
4. Groups I and VIII are product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process of using that product (MPEP 806.05(h)). In the instant case the polypeptides of Group I, may be used for a number of different processes that are very much unrelated. For example, the polypeptides of Group I can be used to make antibodies.
5. Groups II, III, VI and VIII are different methods. They differ because they have different goals, require different method steps and parameters.
6. Groups IV and (II, VI and VIII) are unrelated as product and method of using. The product of Group IV is not required for the method of Groups (II, VI and VIII).
7. Groups IV and III are product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for

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using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process of using that product (MPEP 806.05(h)). In the instant case the active molecules, may be used for a number of different processes that are very much unrelated. For example, the active molecule of Group IV can be used in hybridization assays.

8. Groups V and (II, III and VIII) are unrelated as product and method of using. The product of Group V is not required for the method of Groups (II, III and VIII).

9. Groups V and VI are product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process of using that product (MPEP 806.05(h)). In the instant case the antibody, may be used for a number of different processes that are very much unrelated. For example, the antibody of Group IV can be used in affinity assays.

10. Groups VII and (II and III) are product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process of using that product (MPEP 806.05(h)). In the instant case the products of Group VII, may

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be used for a number of different processes that are very much unrelated. For example, the products of Group VII can be used in hybridization assays.

11. Groups VII and (VI and VIII) are unrelated as product and method of using. The product of Group VII is not required for the method of Groups (VI and VIII).

12. Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Moreover, in the absence of restriction it would place an undue search and examination burden on the examiner.

13. Applicant is advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

14. Applicant is reminded that upon that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).


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15. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 308-4242.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (703) 308-4735. The examiner can normally be reached on Monday – Friday from 7:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.


Vanessa L. Ford
Biotechnology Patent Examiner
October 1, 2003


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600